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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,564	01/30/2001	Akihiro Furukawa	108478	9409
25944	7590	12/19/2005		
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			EXAMINER MEHRPOUR, NAGHMEH	
			ART UNIT	PAPER NUMBER
			2686	

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/771,564

Applicant(s)

FURUKAWA ET AL.

Examiner

Naghmeh Mehrpour

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 11/30/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24 and 27-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24 and 27-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/30/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The information disclosure statement filed reference listed in the information Disclosure Submitted on 11/30/05 have been considered by the examiner (see attached PTO-1449

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 24, 27-33, 35-45, 47-49**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Chapman (US Patent Number 6,522,421 B1) in view of Stenman et al. (US Patent Number 6,223,029 B1) in further view of Fukuta (US Patent 6,173,338 B1).

Regarding **claims 24, 38**, Chapman teaches a control method of controlling an image-forming device, comprising the steps of:

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a) receiving image information from an external device 11 (col 3 lines 29-35);
b) storing the image information in a memory(col 3 lines 35-37); and
c) receiving an instruction to print the image information (col 3 lines 33-37); and
d) executing printing of the image information in accordance with the instruction
(col 3 lines 60-67, col 4 lines 1-17);

a controller 19 that controls the printing unit to execute the printing (col 2 lines 55-67);

Chapman fails to c) executing printing of the print data from a cellular phone. However Stenman teaches c) executing printing of the print data from a cellular phone (col 6 lines 65-67, col 7 lines 1-24), a communication unit that transmits an instruction to the image forming device a cellular phone including a communication unit that transmits an instruction to the image forming device, wherein the controller controls the printing unit to execute the printing the instruction is transmitted from the cellular phone (col 6 lines 65-67 col 7 lines 1-24). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the above teaching of Stenman with Chapman, in order to provide security to the user not only for sensitivity of the information but also the accessibility and location of the receiving equipment. Chapman modified by Stenman fails to teach receiving an instruction to print the image information **after storing the image information in the memory**. However Fukuta teaches receiving an instruction to print the image information **after storing the image information in the memory** (col 7 lines 25-33, col 16 lines 55-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to

combine the above teaching of Fukuta with Stenman modified by Chapman, in order to provide an image output and for beginning to output the image data after an output condition has been designated.

Regarding **claim 27**, Chapman fails to teach a control method wherein **after storing the image information in the memory**, outputting to the cellular phone a signal indicating that the image information is stored in the memory, wherein the instruction is received from the cellular phone after the signal is outputted.

However Stenman teaches a method wherein the instruction is received from the cellular phone (col 7 lines 1-24, col 15 lines 20-21). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the above teaching of Stenman with Chapman, in order to provide security to the user not only for sensitivity of the information but also the accessibility and location of the receiving equipment. Chapman modified by Stenman fails to teach that **after storing the image the image information in the memory**; outputting to a device a signal indicating that the image information is stored in the memory; outputting to a device a signal indicating that the image information is stored in the memory, wherein the instruction is received from a device after the signal is outputted. However, Fukuta **after storing the image the image information in the memory**; outputting to a device a signal indicating that the image information is stored in the memory, wherein the instruction is received from a device after the signal is outputted (col 7 lines 25-33, col 16 lines 59-67). Therefore, it would have been obvious to one of ordinary skill in the art

at the time of the invention to combine the above teaching of Fukuta with Stenman modified by Chapman, in order to provide an image output and for beginning to output the image data after an output condition has been designated.

Regarding **claims 28, 35, 40**, Chapman teaches a controlling method wherein the instruction is an email message transmitted in an e-mail format (col 3 lines 18-20). Chapman fails to teach a method wherein the instruction is received from the cellular phone. However Stenman teaches a method wherein the instruction is received from the cellular phone (col 6 lines 65-67, col 7 lines 1-24). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the above teaching of Stenman with Chapman, in order to provide security to the user not only for sensitivity of the information but also the accessibility and location of the receiving equipment.

Regarding **claims 29, 41**, Chapman teaches a controlling method wherein the instruction is an email message transmitted in via a Web service (col 3 lines 43-53). Chapman fails to teach a method wherein the instruction is received from the cellular phone. However Stenman teaches a method wherein the instruction is received from the cellular phone (col 6 lines 65-67, col 7 lines 1-24). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the above teaching of Stenman with Chapman, in order to provide security to the user not

only for sensitivity of the information but also the accessibility and location of the receiving equipment.

Regarding **claims 30, 36, 42, 48**, Chapman teaches a controlling method wherein the image forming device has a URL (Internet address), and the instruction is transmitted to the image forming apparatus (col 3 lines 43-65). Chapman fails to teach a method wherein the instruction is received from the cellular phone. However Stenman teaches a method wherein the instruction is received from the cellular phone (col 6 lines 65-67, col 7 lines 1-24). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the above teaching of Stenman with Chapman, in order to provide security to the user not only for sensitivity of the information but also the accessibility and location of the receiving equipment.

Regarding **claims 31, 43**, Chapman fails to teach a controlling method wherein the instruction from the cellular phone is transmitted via an audio guidance. Chapman fails to teach a method wherein the instruction is received from the cellular phone. However Stenman teaches a method wherein the instruction from the cellular phone is transmitted via an audio guidance (col 7 lines 52-59). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the above teaching of Stenman with Chapman, in order to provide security to the user not only for sensitivity of the information but also the accessibility and location of the receiving equipment.

Regarding **claims 32, 44**, Chapman fails to teach a control method wherein the instruction from the cellular phone is transmitted in response to the audio guidance. Chapman fails to teach a method wherein the instruction from the cellular phone is transmitted in response to the audio guidance. However Stenman teaches a method wherein the instruction from the cellular phone is transmitted in response to the audio guidance (col 7 lines 52-59). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the above teaching of Stenman with Chapman, in order to provide security to the user not only for sensitivity of the information but also the accessibility and location of the receiving equipment.

Regarding **claims 33, 45**, Chapman teaches a controlling method/printing system comprising the steps of:

f) detecting an e-mail address from the image information stored in the memory (col 3 lines 33-37); and

g) sending an e-mail message to the designation of the detected e-mail address (col 3 lines 33-37), the e-mail message urging a user to transmit the instruction to the image forming device (col 3 lines 60-67, col 4 lines 1-18). Chapman fails to teach a method wherein the instruction is received from the cellular phone. However Stenman teaches a method wherein the instruction is received from the cellular phone (col 6 lines 65-67, col 7 lines 1-24). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the above teaching of Stenman with

Chapman, in order to provide security to the user not only for sensitivity of the information but also the accessibility and location of the receiving equipment.

Regarding **claim 37**, Chapman teaches a control method wherein the URL includes a link to a page to instruct the execution of the printing, and the instruction is sent to image forming device has a URL (Internet address), and the instruction is transmitted to the image forming apparatus (col 3 lines 43-65).

d) executing printing of the image information in accordance with the instruction (col 3 lines 60-67, col 4 lines 1-17).

Chapman fails to c) executing printing of the print data from a cellular phone. However Stenman teaches c) executing printing of the print data from a cellular phone (col 6 lines 65-67, col 7 lines 1-24). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the above teaching of Stenman with Chapman, in order to provide security to the user not only for sensitivity of the information but also the accessibility and location of the receiving equipment

Regarding **claim 39**, Chapman fails to teach a printing system wherein an instruction is received from the cellular phone. However Stenman teaches a method wherein the instruction is received from the cellular phone (col 6 lines 65-67, col 7 lines 1-24).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the above teaching of Stenman with Chapman, in order to provide security to the user not only for sensitivity of the information but also the accessibility

and location of the receiving equipment. Chapman modified by Stenman fails to teach **the image forming device further includes an output unit that outputs** a signal to the output device include indicating that the image information is stored in the memory; and the communication unit transmits the instruction **to the image forming device further includes** the communication unit transmits the instruction **to the image forming device after receiving the signal output from the output unit of the image forming device**. However, Fukuta teaches an **image forming device further includes an output unit that outputs** a signal to an output device include indicating that the image information is stored in the memory; and the communication unit transmits the instruction **to the image forming device further includes** the communication unit transmits the instruction **to the image forming device after receiving the signal output from the output unit of the image forming (col 3 lines 25-30, col 7 lines 25-33, col 16 lines 59-67)**. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the above teaching of Fukuta with Stenman modified by Chapman, in order to provide an image output and for beginning to output the image data after an output condition has been designated.

Regarding **claims 47, 49**, Chapman teaches a printing system method wherein the URL (Internet address) includes link to a page to instruct the printing (col 3 lines 33-56), and the instruction is sent to the image forming device by accessing the link (col 3 lines 57-67, col 4 line 1). Chapman fails to teach a method wherein the instruction is received from the cellular phone. However Stenman teaches a method wherein the

instruction is received from the cellular phone (col 6 lines 65-67, col 7 lines 1-24).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the above teaching of Stenman with Chapman, in order to provide security to the user not only for sensitivity of the information but also the accessibility and location of the receiving equipment.

5. **Claims 34, 46**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Chapman (US Patent Number 6,522,421 B1) in view of Stenman et al. (US Patent Number 6,223,029 B1) and Fukuta (US Patent 6,173,338 B1) in further view of Peyser International publication WO 94/26059.

Regarding **claims 34, 46**, Chapman fails to teach a method wherein the instruction is received from the cellular phone. However Stenman teaches a method wherein the instruction is received from the cellular phone (col 6 lines 65-67, col 7 lines 1-24, col 15 lines 20-21). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the above teaching of Stenman with Chapman, in order to provide security to the user not only for sensitivity of the information but also the accessibility and location of the receiving equipment.

Chapman modified by Stenman and Fukuta fails teaches a control method/printing system wherein the image information forming device determines whether the image information is confidential and the printing is executed when the instruction including a predetermined code is transmitted from the cellular phone.

However Peyser teaches a control method/printing system wherein the image information forming device determines whether the image information is confidential and the printing is executed when the instruction including a predetermined code is transmitted from the cellular phone (page 6 lines 13-17, page 7 lines 21-25, page 8 lines 31-35, page 9 lines 5-16). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine above teaching of Peyser with Chapman modified by Stenman and Fukuta, in order to provide security to the user not only for sensitivity of the information but also the accessibility and location of the receiving equipment.

Response to Arguments

6. Applicant's arguments with respect to claims 24, 27-49 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any responses to this action should be mailed to:

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naghmeh Mehrpour whose telephone number is 703-308-7159. The examiner can normally be reached on 8:00- 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid be reached on (703) 306-3061.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NM

December 7, 2005

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